

BEST AVAILABLE COPY



**UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231.

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
-----------------	-------------	----------------------	---------------------

09/395,805 09/14/99 KINOSHITA

H PM-264009

IM22/0327
PILLSBURY MADISON & SUTRO LLP
INTELLECTUAL PROPERTY GROUP
NINTH FLOOR EAST TOWER
1100 NEW YORK AVENUE NW
WASHINGTON DC 20005-3918

EXAMINER

SHEWAREGED, B

ART UNIT

PAPER NUMBER

1774

DATE MAILED:

03/27/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/395,805

Applicant(s)

Kinoshita et al.

Examiner

Betelhem Shewareged

Group Art Unit

1774

☒ Responsive to communication(s) filed on Jan 8, 2001☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 1 and 4-8 is/are pending in the application

Of the above, claim(s) _____ is/are withdrawn from consideration

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1 and 4-8 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

Art Unit: 1774

DETAILED ACTION

1. Applicant's response filed on 01/08/2001 has been fully considered. All formal rejection have been withdrawn in view of Applicant's amendments and comments.
2. Claims 2 and 3 are canceled, claims 4-8 are added, and claims 1 and 4-8 are pending.

Claim Rejections - 35 USC § 102

3. Claims 1 and 4-8 are rejected under 35 U.S.C. 102(e) as being anticipated by kawatsu et al. (US 6,025,286).

A heat-sensitive stencil sheet comprises a fibrous support of polyester fibers, and a polyester film laminated on the fibrous support. Adhesive may be used for laminating the fibrous support and the polyester film. (Abstract, background art and claim 1). Since the prior art uses the same materials as the current invention, the prior art's invention possesses the claimed properties, (i.e. tensile strength, a value of T-H greater than or equal to 0.150).

Applicant's argument is based on an impression that the prior art's stencil sheet does not inherently possesses the claimed properties. This argument is not found persuasive because the discovery a new property does not make the claimed invention novel. SOMETHING WHICH IS OLD DOES NOT BECOME PATENTABLE UPON THE DISCOVERY OF A NEW PROPERTY. The claiming of a new use, new function or unknown property which is inherently present in the prior art does not necessarily make the claim patentable. In re Best, 562 F.2d 1252, 1254, 195 USPQ 430, 433 (CCPA 1977). Mere recitation of newly-discovered function or property, inherently possessed by things in prior art, does not cause claim drawn to those things

Art Unit: 1774

to distinguish over prior art. Patent Office can require Applicant to prove that subject matter shown to be in prior art does not possess characteristic relied on where it has reason to believe that functional limitation asserted to be critical for establishing novelty in claimed subject matter may be inherent characteristic of prior art. This burden of proof is applicable to product claims reasonably considered as possessing allegedly inherent characteristics. No factual evidence is provided to show that the prior art does not possess the claimed properties, thus claim 1 stand rejected and new claims 4-8 are also included in the rejection.

Conclusion

4. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

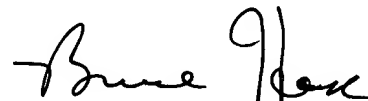
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Art Unit: 1774

5. Any inquiry regarding this communication or earlier communications from the Examiner should be directed to Betelhem Shewareged, whose telephone number is (703) 305-0389. The Examiner can normally be reached Monday to Thursday from 7:30 AM to 6:00 PM.

A facsimile center has been established in Group 1700, Crystal Plaza 3, 8th floor, reception area. The hours of operation are Monday through Friday, 8:45 AM to 4:45 PM. The telecopier number for accessing the facsimile machine is (703) 305-3599 (for official after final faxes) or (703) 305-5408 (for all other official faxes). This location should be used in all instances when faxing any correspondence to Art Unit 1774. Use of the Group 1700 center will facilitate rapid delivery of materials to Examiners in Art Unit 1774.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0651.



BRUCE H. HESS
PRIMARY EXAMINER
GROUP 1300

BS/BS

March 22, 2001.